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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/669,510	09/24/2003	Joachim Horst	P03,0360	4565
26574 7590 07/17/2007 SCHIFF HARDIN, LLP PATENT DEPARTMENT 6600 SEARS TOWER CHICAGO, IL 60606-6473			EXAMINER QIN, YIXING	
			ART UNIT 2625	PAPER NUMBER
			MAIL DATE 07/17/2007	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/669,510

Applicant(s)

HORST, JOACHIM

Examiner

Yixing Qin

Art Unit

2625

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 24 September 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-13 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-3 and 5-13 is/are rejected.
- 7) ☒ Claim(s) 4 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 24 September 2003 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>9/24/03</u> | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Drawings

The drawings are objected to because the headings of the table in Fig. 5 seems to be backwards. From the specification on page 9, it states that the level number (module 4) +1 = operation number, and thus the headings should be level number for the first column and the operation number for the second column. Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

The claimed invention in claims 7 and 8 are directed to non-statutory subject matter. Claims 7 and 8 are rejected under 35 U.S.C. 101 because they are directed towards an abstract idea. Under the current 101 guidelines (specifically, page 30 "Annex I"), there are three 101 judicial exceptions – law of nature, natural phenomenon, and abstract idea. A program is simply a set of instructions and does not produce a physical transformation or a tangible result. The suggested correction is to amend the claims to "A computer-readable medium encoding a software program containing instructions for...." According to the current guidelines, the claims are to be written in the form as given in the suggestion, so the Examiner's suggestion is to write claim 7 with the above preamble and to cancel claim 8, since it would be covered by the newly amended claim 7.

Allowable Subject Matter

Claim 4 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

The following is an examiner's statement of reasons for allowance: No prior art of record has show the claimed relationship between the level numbers and operation numbers by using the modulo + 1 of the level number to arrive at the operation number.

Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

I. Claims 1-3, 4-13 are rejected under 35 U.S.C. 102(b) as being anticipated by the applicant's admitted prior art in the background of the invention (AAPA).

Regarding claims 1, 7-10, 13, the AAPA discloses a method for generating an intelligent printer data stream (IPDS), comprising the steps of:

combining into groups print data describing a plurality of pages to be printed by an IPDS command "DGB"; (Fig. 1 shows print data being grouped)

assigning a respective level to the groups whereby a specific operation number is respectively assigned in advance to the individual levels, the levels are respectively represented by a level number, and the operations are respectively represented by an operation number; (The first five lines of SGO Level = X'..' , Operation = X'..' shows level and operation numbers)

providing a linkage between all level numbers and all operation numbers such that the level numbers can unambiguously be assigned an operation number; (again, the first five lines show the linkage between the level and operation numbers) and

determining by means of the linkage which operation is assigned to a specific level. (again, the first five lines of Fig. 1 and P[0005] shows a linkage between the levels and the operations)

Regarding claim 2, the AAPA discloses the method according to claim 1 wherein all active levels are saved in a table. (Fig. 2, P[0006])

Regarding claim 3, the AAPA discloses the method according to claim 1, wherein the level number is an eight-digit binary number, the operation number is an n-digit binary number where n is smaller than eight, and the linkage is designed such that a specific level number is associated with the operation number that coincides with at least n predetermined digits of the level number. (Fig. 2, item discloses that the range is from X'00' – X'FF')

Regarding claim 5, the AAPA discloses the method according to claim 1 wherein frequently occurring operations are assigned to more levels than less frequently occurring operations. (Fig. 2, the first five lines show that X'01' and X'03' are assigned to more levels.)

Regarding claim 6, the AAPA discloses the method according to claim 1 wherein an active list is maintained in which the level numbers of all active levels are entered. (Fig. 2, item 3 shows the various possible level numbers.)

Regarding claim 11, the AAPA discloses the computer according to claim 10 wherein the computer is a controller to control at least one of a print device, a print pre-processing device, and a print post-processing device. (Fig. 3)

Regarding claim 12, the AAPA discloses the computer according to claim 11 wherein the computer is mechanically separate from at least one of the print device, the print pre-processing device, and the print post-processing device. (Fig. 3)

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Yixing Qin whose telephone number is (571)272-7381. The examiner can normally be reached on M-F 9:30-6:00.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Twyler Lamb can be reached on (571)272-7406. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.


YQ


TWYLER LAMB
SUPERVISORY PATENT EXAMINER